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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/767,474	Applicant(s) OLLIS ET AL.
	Examiner DOHM CHANKONG	Art Unit 2452

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 May 2009.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 - 4a) Of the above claim(s) is/are withdrawn from consideration.
- 5) Claim(s) is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) is/are objected to.
- 8) Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. .
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date:
- 5) Notice of Informal Patent Application
- 6) Other:

DETAILED ACTION

1. This action is in response to Applicant's request for continued examination. Claims 1, 9, 10, and 16 are amended. Claims 1-20 are presented for further examination.

2. This action is a non-final rejection.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/20/2009 has been entered.

Response to Arguments

4. Because the previously cited references do not expressly disclose the limitation where the GAL contacts are visually distinguishable within a contact view on the device from the user's personal contacts, Applicant's arguments with respect to claims 1-9 and 16-20 have been considered but are moot in view of the new ground(s) of rejection. However, because the limitation does not affect the structure of the system of claims 10-15, Applicant's arguments with respect to claims 10-15 are not persuasive.

Claims 10-15 recite a system and therefore it is interpreted as a machine or apparatus. Functional limitations in apparatus claims are problematic because "[w]hile features of an

apparatus may be recited either structurally or functionally, *claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function*" and "apparatus claims cover what a device is, not what a device does." (emphasis added) *MPEP § 2114*. See also *MPEP § 2111.04* ("Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure").

Applicant has amended claim 10 to include limitations reciting that GAL contacts are synchronized differently from personal contacts and that the GAL contacts are visually distinguishable from the personal contacts. These limitations are clearly functional in nature as they relate to how the claimed system processes the GAL contacts; the limitations have no bearing on the system's structure.

Thus, the new limitations in claim 10 do not limit the claim's scope and are ignored for the purposes of this action. The rejection of claims 10-15 as set forth in the previous action are therefore maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant amends claim 1 to include a limitation directed to automatically incorporating the GAL contacts with the user's personal contacts. Applicant argues that this limitation distinguishes the claim over Schwartz because Schwartz discloses prompting the user before adding the GAL contact to the personal contacts. However, Applicant's specification does not provide any written description for this limitation.

Applicant's amendment in fact discloses that the addition of the GAL contact to the personal list is not automatic. The section recites that a GAL contact may be added to the contact list only after the user has selected to edit the GAL contact [Fig. 6 «items 620, 630» | Applicant's printed publication 2005|0164651, 0046]. This teaching therefore requires a manual action in order to add the GAL contact. According to the specification, the only steps described that are performed automatically relate to the automatic selection of GAL contacts and the automatic placement of a contact into an offline GAL store [Applicant's printed publication 20050164651, 0013 & 0039].

For the foregoing reasons, Applicant's limitation directed to automatically incorporating the GAL contacts lacks written description. Because the limitation is without basis in Applicant's specification, it is ignored for the purposes of claim interpretation in this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 10, 11, and 15 are rejected under 35 U.S.C. §102(b) as being anticipated by Huang et al, U.S. Patent No. 5.966.714 ["Huang"].

7. As to claim 10, Huang discloses a system for populating a list of GAL contacts on a device, comprising:

a device including a communication connection, a data store, a display, and a processor that is configured to perform the following actions [*Figure 1a «item 106» | Figure 1c «item 106» | column 5 «lines 36-37»*], including:

connecting to a network using the communications connection to perform a synchronization [*column 5 «lines 17-42»*];

receiving an update list from the network containing information to update global address list (GAL) contacts that are unique from a user's personal contacts [*column 2 «lines 27-31» : a change list | column 4 «lines 5-10» : generating a subset of a large address book*] and are in addition to the user's personal contacts [*see Response to arguments | Fig. 3e «steps 347-355»*];

wherein the GAL contacts are synchronized differently from the user's personal contacts; and wherein the GAL contacts are visually distinguishable within a contact view from the user's personal contacts [*see Response to arguments*];

updating the GAL contacts [*column 4 «line 62» to column 5 «line 1» | column 6 «lines 60-64»*];

storing the updated GAL contacts in the data store [*column 4 «lines 50-54» : memory within the client device*]; and

displaying the GAL contacts on the display [*Figure 1d*]; and

when an edit is made to one of the GAL contacts while stored on the device

adding the edited GAL contact as a personal contact to the user's personal contacts on the device [*see Response to arguments | Fig. 3e «step 353, 354»*];

a server including a communications connection, a data store, and a processor that is configured to perform the following actions [*Figure 1c «items 127, 102»*], including:

obtaining the GAL contacts for the user [*column 6 «lines 8-12»*];

preparing an update list based on the GAL contacts in the data store on the device

and the obtained GAL contacts [*column 7 «lines 26-32» | Figure 3e «item 350»* : preparing the information from the master address book | *column 9 «lines 63-66»*]; and

providing the GAL contacts to a device over the network [*Figure 3e «item 355» | column 9 «lines 63-66»*].

8. As to claim 11, Huang discloses automatically selecting the GAL contacts further comprises obtaining the GAL contacts from the user's emails [*column 5 «line 67» to column 6 «line 7»*].

9. As to claim 15, Huang discloses displaying the GAL contacts along with the user's personal contacts [*Figure 1d*].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3, 5-7, and 9 are rejected under 35 U.S.C. 103(a) as being obvious over Schwartz et al, U.S. Patent Publication NO. 2004/0135816 ["Schwartz"] in view of Kobashikawa et al, U.S. Patent NO. 7.539.699 ["Kobashikawa"].

The applied reference Schwartz has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a

terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

11. All citations are to Schwartz unless otherwise noted.

12. As to claim 1, Schwartz as modified by Kobashikawa discloses a method for populating a list of GAL contacts on a device, comprising:

automatically selecting global address list (GAL) contacts for a user to include on the device in addition to user's personal contacts that are already stored on the device [0021: tracking "non-address book message targets"];

removing any duplicates from the GAL contacts to ensure that the GAL contacts are unique from the user's personal contacts [0044: separate list of new recipients - therefore the addresses in the "non-address book" are unique];

preparing the GAL contacts [0044]; and

providing the GAL contacts to the device [0044];

wherein the GAL contacts are incorporated with the user's personal contacts [0044] and wherein a display of the GAL contacts are visually distinguishable from the user's personal contacts when displayed together within a contact view on the device [*Kobashikawa*, Fig. 2 «items 172, 174»: disclosing separating addresses into different folders but within the same contact view | column 6 «line 46» to column 7 «line 7»];

wherein the user's personal contacts are treated differently from the provided GAL contacts such that the user's personal contacts are maintained during a synchronization that updates the provided GAL contacts [0044 – the non-address book is updated while the user's personal address book is maintained].

As noted above, Schwartz does not expressly disclose a display where the GAL contacts are visually distinguishable from the user's personal contacts when displayed together within a contact view. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by Kobashikawa. Like Schwartz, Kobashikawa is directed to an invention for organizing contact addresses into an address book. Kobashikawa further discloses organizing different contacts into different folders in manner that allows the user to visually distinguish between contacts (because the contacts are placed and displayed in different folders).

In other words, because the contacts are in separate folders but within the same view, they are visually distinguishable to the user. It would have been obvious to one of ordinary skill in the art to have modified Schwartz with this same feature to better organize the user's contact list. For example, Schwartz discloses three different lists: an MFU (most frequently used) list, a list of non-address book recipients, and a general contact list.

As modified by Kobashikawa, Schwartz would organize these different lists into different folders (an MFU folder, a folder for contacts that are not currently in the address book, and a folder for general contacts) so that they can be displayed together but still visually distinguishable. Using folders to organize contacts but also display them within the same contact window would improve Schwartz by better organizing the user's contacts.

13. As to claim 3, Schwartz discloses automatically selecting the global GAL contacts further comprises obtaining the GAL contacts from a user's emails including obtaining a primary addressee from each of a predetermined number of sent emails from the user [0044].
14. As to claim 5, Schwartz discloses determining when one of the GAL contacts on the device is removed by the user and when one of the GAL contacts on the device is removed by the user preventing the removed GAL contact from being provided to the device during the synchronization [0043: removing an entry from the list implies that the entry will not be added to the personal address book].
15. As to claim 6, Schwartz discloses determining when the user edits one of the GAL contacts on the device; and when the user has edited one of the GAL contacts on the device making the one of the GAL contacts one of the personal contacts on the user's device [0044].
16. As to claim 7, Schwartz discloses limiting the number of GAL contacts provided to device [0043].
17. As to claim 9, Schwartz discloses the GAL contacts are obtained from a GAL store on a server [0052: discussing how all the features of the invention can be performed server side].
18. Claims 16, 19, and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Huang in view of Kobashikawa.

19. As to claim 16, Huang discloses a computer-readable storage medium including computer-executable instructions for populating a list of GAL contacts on a device, comprising:

beginning a synchronization session [*column 4 «lines 5-18»*];

automatically selecting global address list (GAL) contacts for a user that in addition to a user's personal contacts on the device and that are unique from the user's personal contacts from the user's emails [*column 4 «line 50» to column 5 «line 4»* : receiving only a subset of the larger address book | *column 6 «lines 1-14»* | *Figure 3e «item 347»* : selecting contacts based on scanning email addresses from a user's Email folders and archives and determining whether the address is already in the user's personal address book (PAB)];

wherein the GAL contacts on the device are synchronized differently from the user's personal contacts on the device [Fig. 3e]; and

wherein the GAL contacts are visually distinguishable within a contact view on the device from the user's personal contacts [*Kobashikawa, Fig. 2 «items 172, 174»*: disclosing separating addresses into different folders but within the same contact view | *column 6 «line 46» to column 7 «line 7»*];

providing the GAL contacts to a device [*Figure 3e «item 355» | column 9 «lines 63-66»*].

As noted above, Huang does not expressly disclose a display where the GAL contacts are visually distinguishable from the user's personal contacts when displayed together within a contact view. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by Kobashikawa. Like Huang Kobashikawa is directed to an invention for organizing contact addresses into an address book. Kobashikawa further discloses organizing

different contacts into different folders in manner that allows the user to visually distinguish between contacts (because the contacts are placed and displayed in different folders).

In other words, because the contacts are in separate folders but within the same view, they are visually distinguishable to the user. It would have been obvious to one of ordinary skill in the art to have modified Huang with this same feature to better organize the user's contact list. For example, Huang discloses organizing messages into folders as well as retrieving only a subset of addresses from the personal contact list.

As modified by Kobashikawa, Huang would organize these different folders and the subset of contacts that are sent to the mobile device into different contact folders (such as a mobile phone contact folder) so that they can be displayed together but still visually distinguishable. Using folders to organize contacts but also display them within the same contact window would improve Huang by better organizing the user's contacts.

20. As to claim 19, Huang discloses providing the GAL contacts to the device further comprising providing updates to the device in order to update a GAL contact store on the device [column 4 «line 62» to column 5 «line 1» | column 6 «lines 60-64»].

21. As to claim 20, Huang discloses maintaining a user snapshot list outside of the device that is related to the GAL contacts for the user [Figure 1c «item 128» | column 6 «lines 37-40» : snapshot of the highest ranked addresses stored at the host device (outside of the user's mobile device)].

22. Claims 12, 14, and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Huang and Kobashikawa, in further view of Kraenzel et al, U.S. Patent Publication No. 2005/0198144 (“Kraenzel”).

23. As to claims 12, 14, and 17, Huang does disclose obtaining a primary addressee from sent emails from the user [column 5 «line 67» to column 6 «line 7» | column 7 «lines 62-65» | column 9 «lines 44-67»], but does not expressly disclose scanning a predetermined number of sent emails from the user. However, the feature of specifying a number of sent emails to be retrieved and scanned was well known in the art at the time of Applicant's invention as evinced by Kraenzel.

Kraenzel is directed towards a system for managing message addressed by extracting the information from emails [*abstract*]. Kraenzel discloses that a user can specify the number of emails to search to extract the addressee information [*Figure 3* : specifying number of messages if more than a certain number | 0060-0062]. It would have been obvious to one of ordinary skill in the art to have adapted Huang's system to include Kraenzel's user selectable filters. One would have been motivated to adapt Huang because the filters increase the amount of control that a user has over the number of messages to be scanned.

24. Claims 13 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Huang and Kobashikawa, in further view of Lake, U.S. Patent No. 7,200,638.

25. As to claims 13, and 18, Huang does not expressly disclose obtaining the GAL contacts from meeting requests. However, the feature of extracting contact information from meeting requests was well known in the art at the time of Applicant's invention as evinced by Lake. Lake is directed towards a system for automatically populating a contact list [*abstract*]. Lake teaches that one of the ways to accomplish this task is to extract the contacts from meeting information found in a user's calendar [*Figure 3 | column 2 «lines 6-11»*]. It would have been obvious to one of ordinary skill in the art to have adapted Huang's system to include Lake's automatic population functionality. Lake teaches that such a feature more efficiently manages a user's contact list [*column 1 «lines 51-62»*].

26. Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schwartz and Kobashikawa, in further view of Kraenzel.

27. As to claim 2, Schwartz discloses obtaining the GAL contacts from emails [*abstract*] but does not disclose obtaining the GAL contacts from other forms of communication. However, extracting contact information from a variety of communications was a well known feature in the art at the time of Applicant's invention as evidenced by Kraenzel. Kraenzel teaches obtaining contacts from phone calls, SMS or IM messages, and user meetings [*0030, 0031*: discussing the application of his extraction feature in a variety of products including instant messaging, discussion forums or other multi-part communication systems]. It would have been obvious to one of ordinary skill in the art that the forms of communication being claimed in claim 2 are contemplated by Kraenzel as multi-part communication systems. It would have been further

obvious to one of ordinary skill in the art to have modified Schwartz's system with the ability to obtain contacts from a wider variety of communications as taught by Kraenzel. Such a modification substantially increases the number of contacts that may be included in the contact list.

28. Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schwartz and Kobashikawa, in further view of Lake.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

29. As to claim 4, Schwartz does not expressly disclose obtaining the GAL contacts from meeting requests. However, the feature of extracting contact information from meeting requests was well known in the art at the time of Applicant's invention as evidenced by Lake. Lake is directed towards a system for automatically populating a contact list [*abstract*]. Lake teaches that one of the ways to accomplish this task is to extract the contacts from meeting information found in a user's calendar [*Figure 3 | column 2 «lines 6-11»*]. It would have been obvious to one of ordinary skill in the art to have adapted Schwartz's system to include Lake's automatic population functionality. Lake teaches that such a feature more efficiently manages a user's contact list [*column 1 «lines 51-62»*].

30. Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schwartz and Kobashikawa, in further view of Calder et al, U.S. Patent Publication No. 2001/0034244 ["Calder"].

31. As to claim 8, Schwartz does disclose maintaining a snapshot list that excludes the user's personal contacts [*0044*] but does not disclose maintaining a snapshot list outside of the device. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by Calder. Calder discloses maintaining several snapshot lists outside of the user's device [*Fig. 4 | 0054*: disclosing multiple fone lists that may be individually downloaded to the handset]. Calder discloses the benefit of this feature allows a user to maintain a variety of contact lists for different purposes and downloading them as needed [*0055*: a list for contacts from a first country and a list for contacts from a second country]. Therefore, it would have been

obvious to one of ordinary skill in the art to have modified Schwartz to include the snapshot list feature as taught by Calder.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner, Art Unit 2452*